

REMARKS

In a non-final Office Action, claims 1-4, 25-26 and 83-85 were pending. By way of this amendment, claims 1, 4 and 26 have been amended, and claims 3 and 25 have been canceled. Cancellation and amendment of the claims is made without prejudice, without intent to abandon any originally claimed subject matter, and without intent to acquiesce in any rejection of record. Applicants expressly reserve the right to file one or more continuing applications hereof containing the canceled or original claims.

Applicants thank the Examiner for withdrawal of the objection and rejections of the final Office Action dated June 25, 2008.

I. Rejection of Claim 85 Under 35 U.S.C. § 112

Claim 85 stands rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner states that “[w]hile page 5 of the original specification discloses that Appendix B of the specification teaches all of the NMB open reading frames of the sequence, no Appendix B has been filed in the instant application, nor are there any other papers disclosing the ORFs designated by the NMB numbers” (Office Action, page 3). Applicants respectfully disagree with this rejection and its supporting remarks. Applicants remind the Examiner that the instant application is a national phase of PCT/US2000/05928, published as WO 00/66791, and as such the instant application is identical to the international application save for any amendments submitted during prosecution of the instant application. Moreover although the parent PCT application was filed with the United States Receiving Office (US/RO), obviating the need for submission of a copy of the international application to complete the filing under 35 U.S.C. 371, Applicants mailed a copy of WO 00/66791 to the Office on October 30, 2001. As evidenced by the copy of the return receipt postcard attached hereto at Tab A, WO 00/66791 is 692 pages in length. For the Examiner’s convenience, a copy of WO 00/66791 is submitted herewith, with pages 652-687 of the PDF corresponding to Appendix B. Thus regardless of the lack of Appendixes in the online description of WO 00/66791 provided by WIPO, the instant application does indeed include the Appendixes, with page 8 of Appendix B (page 659 of the PDF)

disclosing the putative open readings frames of NMB0427-NMB0430. Since support for Claim 85 is present in Appendix B, which is shared by the parent international application and the instant national phase application, Claim 85 does not contain new matter. Accordingly, Applicants respectfully request that this rejection be withdrawn.

II. Rejection of Claims Under 35 U.S.C. § 103(a)

Claims 1, 2, and 83-85 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Ribot et al., WO 98/17805 (“Ribot”) in view of Chee et al., US Patent No. 5,795,716 (“Chee”). The Examiner contends that Ribot discloses aspects of the claimed invention, but “does not discuss analysis of the entire instant SEQ ID NO. 1 from *N. meningitidis*” and “does not discuss the computer storage medium or user display” (Office Action, page 6). In addition, the Examiner states that the difference between Ribot and the claimed invention “constitutes nonfunctional descriptive material because the content of the nucleic acid database does not alter how the method functions,” and relies upon Chee for disclosure of a computer-aided visualization and analysis system for sequence evaluation (Office Action, page 7).

Applicants thank the Examiner for indicating that “a possible solution to overcoming this rejection is to incorporate withdrawn claim 3 into instant claim 1 wherein the physical expression of proteins from the actual sequence (i.e. not just an *in silico* representation of SEQ ID NO 1 is required)”...[or to] add a verification step between the computer and empirical method steps to observe whether the *in silico* method has succeeded (Office Action, page 9). Although Applicants respectfully traverse this rejection and its supporting remarks, Applicants have amended the claims as suggested by the Examiner. In particular, Applicants have introduced elements from claim 3 (now canceled), into claim 1, and have amended claims 4 and 25 to depend upon claim 1 and to correct antecedence issues, in order to facilitate prosecution of this case and without prejudice or disclaimer. Support for the amendment of claim 1 can be found but is not limited to the teaching that the “proteins of the invention can, of course, be prepared by various means (e. g., recombinant expression, purification from cell culture, chemical synthesis, etc.) and in various forms (e. g. native, fusions etc.)” (Specification, page 7, lines 16-18). Additional support can be found but is not

limited to the teaching that an “amino acid sequence identified in this way can be expressed using any suitable system to give a protein” and this protein in turn “can be used to raise antibodies which recognize epitopes within the identified amino acid sequence (Specification, page 8, lines 19-21). To this end, Examples 2-10 disclose the expression of proteins having amino acid sequences of open reading frames of *N. meningitidis* serogroup B strain MC58 genome.

There are multiple differences between the SEQ ID NO:1 of claim 1 and the *Neisseria* sequence of Ribot, while Chee is devoid of *Neisseria* sequences. As such the amino acid sequences of the proteins produced by the claimed methods would differ from proteins derived from methods relying upon a combination of Ribot and Chee. Additionally, Claim 86 specifically excludes the putative open reading frames in the region of the *N. meningitidis* genome examined by Ribot, providing a further difference between the claimed methods and the combination of Ribot and Chee. Thus without more, since the differences between the pending claims and the combination of Ribot and Chee are more than nonfunctional descriptive material, the pending claims are not obvious. As such, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding objection and rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. **03-1952** referencing attorney docket no. **223002100400**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

In addition, please direct all further communications in this application to:

Amy Hessler
Novartis Vaccines and Diagnostics, Inc., Intellectual Property – X-168
P.O. Box 8097
Emeryville, CA 94662-8097
Tel: (510) 923-3004
Fax: (510) 655-3542

Dated: July 2, 2009

Respectfully submitted,

By /Christine Lekutis/
Christine Lekutis
Registration No.: 51,934
MORRISON & FOERSTER LLP
425 Market Street
San Francisco, California 94105-2482
(415) 268-7060